Ser. No. 10/567,677   PU030178
CUSTOMER NO. 24498
Amendment dated March 3, 2010
Reply to Office action of December 22, 2009

REMARKS

The Office Action mailed December 22, 2009 has been reviewed and carefully considered.
No new matter has been added.

Claims 1, 7, and 13 have been amended. Claims 1-20 are pending.

Claims 1 and 7 stand objected to because of alleged informalities. The Applicants
respectfully disagree. Claim 1, lines 2-3 recite the following: "transmitting a user initiated request
from a user of a mobile device to a wireless service provider of a wireless network for a location of
a wireless local area network (WLAN)". The recited "user initiated request" in line 2 of Claim 1 is
a request and is not the "user" later recited in that line. Hence, the use of the word "a" before the
word "user" in the clause "from a user" in line 2 of Claim 1 is believed to be proper as currently
written. Claim 7, line 4 (as well as the entire claim) is believed to be proper as currently written
for the same reasons as Claim 1. Hence, withdrawal of the objection is respectfully requested.

Claims 1-18 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.
Patent Publication No. 2004/0203873 to Gray (hereinafter "Gray") in view of U.S. Patent No.
7,047,036 to Shaheen et al. (hereinafter "Shaheen"). Claim 19 stands rejected under 35 U.S.C.
103(a) as being unpatentable over Gray in view of Shaheen in view of U.S. Patent Publication No.
2004/0156372 to Hussa (hereinafter "Hussa").

It is to be noted that the independent claims in the case are Claims 1, 7, and 13.

It is respectfully asserted that Gray does not teach or suggest "providing, responsive to
said receiving step, a user with a menu option selection in a mobile device for selecting a distance
or distance range from a wireless service area of the wireless network to said location of said
wireless local area network (WLAN)", as now recited in amended Claim 1.

Moreover, it is respectfully asserted that Gray does not teach or suggest "wherein a user is
provided, responsive to receiving over said wireless network said location of said wireless local
area network (WLAN), with a menu option selection for selecting a distance or distance range
from a wireless service area of the wireless network to said location of said wireless local area
network (WLAN)", as now recited in amended Claim 7.

Further, it is respectfully asserted that Gray does not teach or suggest "providing,
responsive to said mobile device receiving the location of the wireless local area network
(WLAN), a user with a menu option selection for selecting a distance or distance range from the
wireless service area of the wireless network to the location of the wireless local area network
(WLAN)", as now recited in amended Claim 13.

Support for the amendments to Claims 1, 7, and 13 may be found at least at page 6, lines
16-25 of the Applicants' specification, which is directed to step 37 of Figure 3 which involves the

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receiving of the wireless local area network (WLAN) locations by the mobile device and any attendant steps that may be performed at that time or thereafter in response to receiving such locations.

In contrast to the preceding recited limitations of Claims 1, 7, and 13, Gray is completely silent regarding the same. For example, Gray does not include even one occurrence of the word "menu", let alone "menu option selection", let alone the remaining detailed limitations involving the same recited in Claims 1, 7, and 13. Moreover, Gray does not include even one occurrence of the word "distance", let alone the remaining detailed limitations involving the same recited in Claims 1, 7, and 13. Further, while Gray does include (only) two occurrences of the word "range" in paragraph [0007] thereof, the word "range" as disclosed therein has no bearing on and, thus, does not teach or suggest, the explicit limitations recited in Claims 1, 7, and 13 relating to range. For example, paragraph [0007] of gray discloses the following, with the two occurrences of the word "range" emphasized in bold font:

> Although the generally available data transmission rates of the WAN are adequate to support many current wireless voice and data services, such as email, cellular calls and the like, it is not suitable for transmitting, receiving, uploading or downloading a video file or a large data file such as an attachment to an email. A typical WAN cell site covers a few kilometers while a typical IEEE 802.11b WLAN access point covers about 100 meters. Therefore, a user may be within **range** of a WAN base station yet out of **range** of the higher data rate WLAN access point. Additionally, the WAN user connected to a WAN network is generally unaware of and/or can't locate nearby access points to access and utilize a high bandwidth transmission system, such as a WLAN-based network.

Thus, Gray simply discloses with respect to the word "range" that a user may be within the range of a WAN base station but not within the range of a WLAN access point. The preceding has nothing to do with a menu selection option or a user specifying a distance or range, let alone the remaining limitations recited in Claims 1, 7, and 13.

Hence, it is clear that Gray is silent with respect to the above reproduced limitations of Claims 1, 7, and 13. Allowing a user at the mobile terminal as per Claims 1, 7, and 13 to specifically tailor search results (regarding the locations of multiple WLANs) to a particular distance or range as per the above claims allows greater versatility, and enables a user to specifically take into account his or her particular circumstances with respect to driving towards a WLAN. For example, should a user notice that he or she has a certain (i.e., limited) amount of gas

left, the user may want to restrict the range to a smaller range than that used by the communication network itself to provide the specified WLANs. In this way, the user may reduce the overall number of WLANs that have to be evaluated by the user. These and many other attendant advantages are present in the approach claimed in the above claims versus the prior art.

Hence, it is respectfully asserted that Gray does not teach or suggest all of the above reproduced limitations of Claims 1, 7, and 13.

Moreover, it is respectfully asserted that the remaining references do not cure the deficiencies of Gray, and are silent with respect to the above reproduced limitations of Claims 1, 7, and 13.

For example, Shaheen, similar to Gray, does not include even one occurrence of the word "menu", let alone "menu option selection", let alone the remaining detailed limitations involving the same recited in Claims 1, 7, and 13. This is not surprising, since Shaheen has no need for a menu option selection for selecting a distance or distance range from a wireless service area to the location of a WLAN, since Shaheen discloses that the user equipment (UE) itself tracks the location of WLAN coverage areas and, hence, would have no need to specify a distance or distance range to another entity since the UE in Shaheen ALREADY KNOWS the locations of the WLAN coverage areas due to its own tracking of the same. For example, column 1, lines 34-37 of Shaheen discloses that "the UE may track the locations of WLAN coverage areas and initiate the RO process within a specific range from the WLAN."

Moreover, while Shaheen does include occurrences of the word "range" such occurrences relates to when a hand-off is performed (i.e., when a mobile device is within range; see, e.g., Shaheen, col. 2, lines 38-41), and not to providing a user with a menu option selection for selecting a distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network (WLAN) as recited in Claims 1, 7, and 13.

Hence, Shaheen also does not teach or suggest all of the above reproduced limitations of Claims 1, 7, and 13.

Moreover, as noted above, Hussa also does not cure the deficiencies of Gray. For example, Hussa also does not include even one occurrence of the word "menu", let alone "mention option selection, let alone providing a user with the same, let alone the remaining detailed limitations involving the same recited in Claims 1, 7, and 13. In fact, Hussa teaches away from the same. For example, Hussa discloses that "at least one network access point external to the mobile communication network is selected on the basis of predetermined criteria" (Hussa, para. [0022]). Thus, in contrast to providing a user with a menu option selection responsive to receiving the location(s) of the wireless local area network(s), Hussa obtains and stores such criteria before hand, i.e., before the location(s) of the WLAN access point(s) has been sent to the user. For

example, Figure 5 of Hussa shows data repository 406/407 storing "selection criteria", where the data repository corresponds to a network element (see, e.g., Hussa, para. 0042) and not to a mobile device to allow the same to provide such menu selection option <u>responsive to receiving</u> the location information as recited in Claims 1, 7, and 10. Hence, in this regard, Hussa actually teaches away from the above reproduced limitations of Claims 1, 7, and 13.

Hence, Hussa also does not teach or suggest all of the above reproduced limitations of Claims 1, 7, and 13.

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely "consider" each and every feature for this claim. Instead, the asserted combination of the patents must also teach or suggest *each and every claim feature. See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." *See In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Thus, Claims 1, 7, and 13 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above.

Claims 2-6 and 19 directly or indirectly depend from Claim 1 and, thus, include all the limitations of Claim 1. Claims 8-12 directly or indirectly depend from Claim 7 and, thus, include all the limitations of Claim 7. Claims 14-18 and 20 directly or indirectly depend from Claim 13 and, thus, include all the limitations of Claim 13. Accordingly, Claims 2-6 and 19 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 1, Claims 8-12 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 7, and Claims 14-18 and 20 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 13.

Accordingly, reconsideration of the rejections is respectfully requested.

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In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of December 22, 2009 be withdrawn, that pending Claims 1-20 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no further additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicants' Deposit Account No. 07-0832.

Respectfully submitted,

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